



UNITED STATES DEPARTMENT OF COMMERCE
Pat nt and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
087750-715	03/19/97	EIGEN	160752050

MM41/1216
JACOBSON PRICE HOLMAN & STERN
PROFESSIONAL LIMITED LIABILITY CO
400 SEVENTH STREET NW
WASHINGTON DC 20004

EXAMINER
NOLAND, T

ART UNIT	PAPER NUMBER
2856	17

DATE MAILED: 12/16/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/50,715

Applicant(s)

Eigen et al

Examiner

Tom Nelson

Group Art Unit

2856

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 12/1/98
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 33-46 and 53-59 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 33-46 and 53-59 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 15 filed 12/1/98
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 2856

1. The amendment filed December 1, 1998 has been entered.
2. The request filed on Dec. 1, 1998 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/750,715, filed March 19, 1997, is acceptable and a CPA has been established. An action on the CPA follows.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 33-46 and 53-59 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not understood from page 6, lines 2-14 or elsewhere in the disclosure how the generated signal defines the volume element, determines the time to transfer the volume element, and controls the transfer as set forth in claim 33. How this is done does not appear to be readily apparent to one of ordinary skill in the art. It is unclear if applicant is relying on PCT/EP94/00117 for this.

5. To be in better form in claim 33, line 5 "said" should be -- the --. In line 7 "to" should be -- to the --. In line 9 -- -- another environment -- -- is misspelled. In line 10 --- component --- is. In line 11 -- environment --- is. In claim 34, line 3 --- apertures --- is misspelled. In line 4 "by" should be --- by a ---. In line 5 "to" should be --- to the ---. In claim 37, line 2 "said wall" should be --- the wall --. In claim 38, line 1 "said" should be -- the -- and "the" should

Art Unit: 2856

be -- an --. In claim 39, line 1 " the " should be deleted. Correction is required.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 36, 38-41, 54-56 and 58-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claiming of alternatives as in claim 36 is unclear. It should be written in Markush type language. Limitations such as "and/or" as in claim 38, line 3 and claim 39, line 5 are unclear. It is unclear what is meant by "is in electrically contacts" in line 5 of claim 38. In claim 39, line 5 "the other environment receptor compartment" should be -- a receptor compartment in the other environment ---. Claims 54-56 are unclear because of the alternative claiming therein. Claim 55 is also unclear because it is unclear what is meant by 'claim 55" in line 1. Claims 58 and 59 are also unclear since dependent claims but claiming a device when base claims were directed to a method. It is unclear what is meant by "preferably" in claim 59, line 6.

8. Claim 33 is rejected under 35 U.S.C. 102(b) as being anticipated by Eigen et al.

Note specially the abstract and the first two text paragraphs on pages 5740 and 5741. Applicants statement that the claims as amended overcome all rejections was noted but since at least claim 33 appears broader than canceled claim 1 and thus Eigen et al would appear to still anticipate claim 33.

Art Unit: 2856

9. Claims 33-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al, Ashkin et al, North, Jr., Gohde et al., or Weber et al.

The reasons are substantially equivalent to those given in paragraph 13 in the prior Office action, paper no. 8 mailed January 30, 1998, since any differences appear to be known or obvious to one of ordinary skill in the sample handling and analysis arts since similar such techniques are known therein.

10. Applicant's arguments filed June 1, 1998 have again been fully considered but they are not persuasive. Applicants statement then that the claims as amended overcome the rejections have been noted but since essentially claiming the same invention the claims appear to be rejectable at least under 35 U.S.C. 112(1), 102, and 103 for reasons substantially equivalent to those set first in the office action identified as paper no. 8.

11. The claims remaining herein are identical to those finally rejected in the last office action and no additional argument or evidence concerning them has been presented. Therefore, even though this is a first action in a CPA application:

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Serial Number: 08/750,715

Page 5

Art Unit: 2856

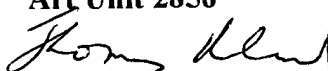
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Noland whose telephone number is (703) 305-4765.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7382.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.

Thomas P. Noland
Primary Examiner
Art Unit 2856



tpn
Dec. 11, 1998